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Paper No. 14

In re Application of
Christopher W. Gabrys et al
Application No. 09/630,157
Filed: July 31, 2000
Attorney Docket No.: 5434
For: FLYWHEEL HUB - TO - RIM COUPLING

DECISION ON PETITION
UNDER 37 CFR §1.181

This is a decision on appellants' petition under 37 CFR 1.181 filed January 2, 2003 requesting that the amendment under 37 CFR 1.116 and the affidavit of Dennis Simmons filed October 7, 2002 be entered.

The petition is **DENIED**.

The record reflects that on September 20, 2001 an Office action was mailed requiring an election of species between the species of Figures 1-4 and Figures 5-6. On November 26, 2001, appellants' elected without traverse the species of Figures 5-6, claims 1-8 and 10-20. On February 1, 2002 a non-final Office action was mailed rejecting claims 1-6 and 10-20 under 35 U.S.C. 112, first paragraph, rejecting claims 10-20 under 35 U.S.C. 112, second paragraph, and rejecting claims 7 and 8 under 35 U.S.C. 102. On May 10, 2002 appellants' filed an amendment amending claims 7, 10, and 16, and arguing the 35 U.S.C. 112, first and second paragraph, rejections. On June 7, 2002 a final Office action was mailed rejecting claims 1-8 and 10-20 under 35 U.S.C. 112, first paragraph, rejecting claims 7, 8, and 10-20 under 35 U.S.C. 112, second paragraph, and rejecting claims 7 and 8 under 35 U.S.C. 102. On October 7, 2002 appellants filed an affidavit by Dennis Simmons and an amendment under 37 CFR 1.116 amending claims 7, 10, 13, 15, and 16. On October 30, 2002 an Advisory Action was mailed denying entry of the amendment under 37 CFR 1.116 as the proposed changes to claim 7 raised new issues that require further consideration and/or search because claim 7 adds the limitation that the rim liner is disposed inside the rim. On November 7, 2002 appellants' filed a Notice of Appeal and a Request for Reconsideration of the denial of entry of the non-entered amendment under 37 CFR 1.116 filed October 7, 2002. On December 6, 2002 an Advisory Action was mailed denying the request for reconsideration.

Appellants' argue that the affidavit is timely because in the final Office action mailed June 7, 2002 the Examiner invited appellant to provide evidence to show that know-how

exists, without extensive research by the manufacturing industry, to follow the teachings in the specification to produce the claimed invention. Appellants' next argue that the amendment to claim 7 does not raise a new issue because the limitation that the rim liner is "inside said flywheel rim" is not a new issue and was already searched and considered by the Examiner in his consideration of original and amended claim 15, which called for an annular rim liner engaged with the inner circumferential surface of an annular rim. Appellants' further argue that the entry of the amendment filed under 37 CFR 1.116 would simplify the issues for appeal as it resolves the two 35 U.S.C. 112, second paragraph, rejections and incorporates into claim 7 the subject matter from allowable claim 3, the limitation that the rim liner is "inside said flywheel rim" being a further limitation to the allowable subject of claim 3.

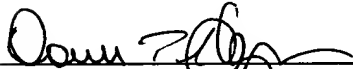
With regard to appellant's argument that the affidavit is timely, MPEP 716.01 states that an affidavit submitted under 37 CFR 1.132 and other evidence traversing rejections is considered timely if submitted after final rejection and submitted (i) with a first reply after final rejection for the purpose of overcoming a new ground of rejection or requirement made in the final rejection, or (ii) with a satisfactory showing under 37 CFR 1.116(b) or 37 CFR 1.195, or (iii) under 37 CFR 1.129(a). As the final Office action provided no new ground of rejection or requirement requiring the affidavit and appellants' have provided no showing under 37 CFR 1.116(b) or 37 CFR 1.195 the examiner's refusal to enter the affidavit is proper.

With regard to appellants' argument that the failure to enter the amendment under 37 CFR 1.116 is improper because the limitation that the rim liner is "inside said flywheel rim" is not a new issue as this limitation was already in claim 15 and in claim 3, a review of the record does not show that the limitation that the rim liner is "inside said flywheel rim" was previously set forth in claims 15 and 3. Claim 15 requires "a rim liner engaged with said inner circumferential surface of said inner annulus" and claim 3 requires (since it depends from claim 1) "an annular flywheel rim on said rim liner". Accordingly, the limitation set forth in claim 7 that the rim liner is "inside said flywheel rim" is broader than the limitations set forth in claims 15 and 3 that require that the rim liner engage the flywheel. Therefore, the broadening in scope of the limitation included in claim 7 raises a new issue that would require further consideration and/or search and is a proper grounds for not entering an amendment filed under 37 CFR 1.116.

With respect to appellants' argument that the amendment filed under 37 CFR 1.116 would simplify the issues for appeal because it corrects two 35 U.S.C. 112, second paragraph, rejections and incorporates the allowable subject matter from claim 3 into claim 7, these arguments are deemed moot as the amendment does not incorporate all of the allowable subject matter of claim 3 into claim 7, rather, it broadens the scope of claim 3 for the reasons set forth above and thus does not simplify the issues for appeal.

The petition is **DENIED**.

The application will be returned to the examiner for immediate action consistent with this decision including the preparation of a supplemental Advisory Action indicating reasons that the affidavit of Dennis Simmons is not persuasive.



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